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REMARKS

STATUS SUMMARY

Claims 12 – 17, 22 and 25 – 48 are pending in the present application. Claims 25 – 48 are currently withdrawn from consideration due to a restriction requirement and concomitant constructive election of claims 12 – 17 and 22. Claim 12 is objected to because of an informality. Claims 12, 13 and 22 presently stand rejected. Claims 14 – 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 1 – 11, 18-21, 23 and 24 were previously canceled without prejudice. Claim 12-14 have been amended herein.

ELECTION/RESTRICTIONS

According to the Office Action dated July 29, 2004, which has been made final, the respective inventions recited in previously added claims 25-48 are considered by the Examiner to be distinct from the respective inventions recited in the claims originally filed with the application. The Examiner requires restriction to one of the following inventions:

- I. Claims 12-17 and 22, drawn to a subcombination apparatus for routing optical signals, classified in class 385, subclass 16.
- II. Claims 25-48, drawn to a combination apparatus and method for routing optical signals, classified in class 385, subclass 15

Applicants respectfully traverse, and request reconsideration of, this restriction requirement for the following reasons.

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According to the US Manual of Classification, class 385 is for "optical waveguides", subclass 15 is for "optical waveguides with optical coupler" and subclass 16 is for "optical waveguides with optical coupler", and further with a "switch". The US Manual of Classification indicates that subclass 16 is indented under subclass 15. The US Manual of Classification further describes subclass 15 as "Subject matter wherein an optical waveguide is combined with an interface element which enables efficient transfer of light between the waveguide and a point external to the interface element." The US Manual of Classification further describes subclass 16 as "Subject matter wherein the output of an optical waveguide is selectively coupled to the input of a different optical waveguide." These descriptions given in the US Manual of Classification indicate that subclasses 15 and 16 cover very similar subject matter. Prior art references of record in the present application and relevant to the pending claims would appear to be classifiable in either or both of subclasses 15 and 16. Therefore, Applicants respectfully submit that a search and examination of both claim groups in the present application does not pose a serious burden on the Examiner. *See* MPEP § 803.

Independent claim 12 recites "an optical channel selection device . . . comprising a rotary element and an optical fiber". The rotary element is "rotatable for aligning the fiber output end with a selected one of a plurality of available optical channels." Claim 12 also recites "a plurality of optical return lines corresponding to the optical channels". Assuming, only for the purpose of traversing the restriction requirement, that the "rotary element" can be characterized as an interface element, the "optical fiber" can be characterized as a waveguide, and the "optical return lines" or a selected one of these can be characterized as a point external to the interface element,

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it appears that claim 12 could have been classified subclass 15 as well as, or alternatively to, subclass 16.

Independent claim 25 recites an "optical input selection device" and an "optical output selection device". Independent claim 34 also recites an "optical input selection device" and an "optical output selection device". Independent claim 39 recites "rotating the rotary member to a position corresponding to a selected optical channel at which the internal optical path can optically communicate with a corresponding one of a plurality of optical source lines and a corresponding one of a plurality of optical return lines separate from the optical source lines". Thus, each respective invention recited in claims 25, 34, and 39 is directed to an apparatus or method by which the output of an optical waveguide can be selectively coupled to the input of a different optical waveguide. It thus appears that claims 25, 34 and 39 could have been classified subclass 16 as well as, or alternatively to, subclass 15.

In view of the foregoing, it again appears that subclasses 15 and 16 cover very similar subject matter. Accordingly, Applicants respectfully submit that a search and examination of both claim groups does not pose a serious burden on the Examiner. *See* MPEP § 803.

Moreover, claims 1-11, 18-21, and 23-24 were originally filed with the application but voluntarily canceled by Applicants in a previous amendment. Claims 1-11, 18-21, and 23-24 were searched and examined by the Examiner and were not subject to a restriction requirement. The set of canceled claims 1-11 and 23, and the set of previously added claims 25-38, 43 and 44, both recite (expressly or by dependency) an "input selection device" and an "output selection device" for optical signals. It thus appears that claims 25-38, 43 and 44 would have been

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classified in the same class as claims 1-11 and 23, for which a search and examination have already been made.

Claims 12-17 and 22 were searched by the Examiner and are currently under examination. Claims 12-17 and 22 recite (expressly or by dependency) a "rotary element" that is rotatable for effecting the selection of an optical channel or selectively coupling optical lines. Claims 28-30 and 34-48 similarly recite (expressly or by dependency) a "rotary member" that is rotatable for effecting the selection of an optical channel. It thus appears that claims 28-30 and 34-48 would have been classified in the same class as claims 12-17 and 22, for which a search and examination have already been made.

In view of the foregoing, Applicants respectfully submit that claims 25-48 do not require separate classification, separate status in the art, or a different field of search from that already searched by the Examiner. Accordingly, Applicants respectfully submit that a *prima facie* case for the propriety of the restriction requirement has not been made. *See* MPEP § 803.

In the alternative, Applicants respectfully submit that even assuming the restriction requirement is proper, the retention of claims 25-48 for prosecution in the instant application does not pose a serious burden on the Examiner as demonstrated by the foregoing arguments. *See* MPEP § 803.

Therefore, Applicants respectfully request that the restriction requirement, and constructive election of claims 12-17 and 22 to the exclusion of claims 25-48, be withdrawn and that claims 25-48 be examined in the present application. In addition, in the event that the Examiner withdraws the restriction requirement, Applicants further respectfully request that the finality of the Office Action be removed.

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OBJECTION TO CLAIM 12

Claim 12 is objected to because of the informality that "over more or more" should be "over one or more". As indicated above, claim 12 has been amended to correct this typographical error. Therefore, Applicants respectfully submit that the objection to claim 12 has been overcome, and respectfully request that this objection be withdrawn.

CLAIM REJECTIONS - 35 U.S.C. § 103

Claims 12, 13, and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kassel et al. (U.S. Patent No. 3,697,185). As to each rejected claim, Applicants respectfully traverse this rejection in view of the amendment made to independent claim 12.

Claim 12 has been amended to recite that the optical channel selection device comprises "a rotary element", and that the optical fiber is "disposed in the rotary element". Kassel et al. fail to teach, suggest, or provide motivation for these features.

Claims 13 and 22 depend from claim 12 and therefore are patentable at least for the same reasons.

In view of the foregoing, Applicants respectfully submit that claims 12, 13 and 22 are patentable under 35 U.S.C. § 103(a) over Kassel et al., and therefore request that the rejection to claims 12, 13 and 22 be withdrawn.

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OTHER CLAIM AMENDMENTS

Apart from the amendments specifically discussed hereinabove, the following is a summary of other claim amendments. These other amendments are believed to be supported by the application as originally filed. Accordingly, no new matter is believed to have been added.

Claim 12 has been amended to recite "optical return lines" instead of "fiber-optic return lines". This amendment renders claim 12 more consistent with claim 22, in which the language "optical return lines" was originally presented and is currently recited.

Claim 13 has been amended to better conform to the amendment to claim 12 just discussed.

Claim 14 has been amended to conform to the amendments made to claim 12.

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CONCLUSION

In light of the above amendments and remarks, it is respectfully submitted that the present application is now in proper condition for allowance, and an early notice to such effect is earnestly solicited.

If any small matter should remain outstanding after the Patent Examiner has had an opportunity to review the above Remarks, the Patent Examiner is respectfully requested to telephone the undersigned patent attorney in order to resolve these matters and avoid the issuance of another Office Action.

Respectfully submitted,

THE ECLIPSE GROUP

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